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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,970	06/30/2000	Kia Silverbrook	NPA015US	1454
24011	7590	09/01/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/608,970	Applicant(s) SILVERBROOK ET AL.	
	Examiner Firmin Backer	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 8th, 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danielle (U. S. Patent No. 5,444,779) in view of Fox et al (U.S. PG Pub 2003/0069873).

4. As per claims 1 and 6, Danielle teaches a method and system of collecting a copyright fee (*electronic copyright royalty accounting system*) relating to a document when a user (*user*) obtains via coded data disposed on a surface (*printed copyright document*) (*see abstract, fig 2*), the document, the method including in a computer system (*database type system, 54*) recording a copyright owner relating to a portion of the document (*see column 8 lines 22-39*), receiving

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(sense) from a sensing device (*glyphs detector, 30*), indicating data indicative of a request for the document (*document to be printed*), the sensing device, when placed in an operative position relative to the surface, generating the indicating data using one of the coded data (*see fig 3, 4, column 8 line 40-9 line 26*), determining the fee from the ownership and debiting a user account associated with the user in the amount of the fee (*see column 9 line 39-10 line 35 11 line 45-12 line 39*) Danielle further teach an inventive concept system wherein the coded data is indicative of a region of the surface of the reference point of the region and a position of the sensing device (*see column 5 line 7-47*). Danielle fails to teach an inventive concept of identifying in the database identifying the request document, retrieving the document from the document database and providing the document to the user. However, Fox et al teach an inventive concept inventive concept of identifying in the database identifying the request document, retrieving the document from the document database and providing the document to the user (*see paragraph 0014, 0017, 0039-0041*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Danielle's inventive concept to include Fox et al's inventive concept of identifying in the copyright database and from the indicating data, the copyright owner relating to the document because this would have provided a method for quickly and efficiently search the document data base and present the result in a meaningful manner.

5. As per claims 2 and 7, Danielle teaches a method and system further comprising crediting the owner account of the fee (*see fig 3, 4, column 8 line 40-9 line 26*).

6. As per claims 3 and 8, Danielle teaches a method and system further printing the document (*see fig 3, 4, column 8 line 40-9 line 26*).

7. As per claims 4 and 9, Danielle teaches a method and system further receiving device identity of the user and identifying the user account (*see column 8 lines 22-39*).

Response to Arguments

7. Applicant's arguments filed June 8th, 2004 have been fully considered but they are not persuasive.

a. Applicants argue that the prior art (Danielle) cannot identify a request for a document from an indicating data which was in turn determined by sensing coded data. Examiner respectfully disagrees with applicant characterization of the prior arts. Danielle, teach a system to account for copyright royalties accrued as a result of printing a copyrighted document on a document printer. Danielle's system included a digitized representation of the copyrighted document having a printable code on each page thereof, the representation being provided for reproduction by the document printer. The system is capable of detecting the presence of the printable code in the digitized representation of the copyrighted document and for decoding the printable code for determining a copyright royalty due for reproduction of the copyrighted document; and accounting means for recording the copyright royalty due. The concept including an apparatus, associated with a reprographic device, for tracking the reproduction of at least a portion

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6. As per claims 3 and 8, Danielle teaches a method and system further printing the document (*see fig 3, 4, column 8 line 40-9 line 26*).

7. As per claims 4 and 9, Danielle teaches a method and system further receiving device identity of the user and identifying the user account (*see column 8 lines 22-39*).

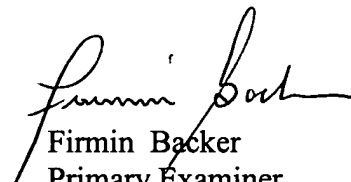
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer
Primary Examiner
Art Unit 3621

August 31, 2004